

The opinion in support of the decision being entered today was *not* written for publication in a law journal and is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte WILLIAM T. GRAUSHAR and JOHN C. GERES

Appeal 2006-3001
Application 10/747,840
Technology Center 3600

Decided: February 21, 2007

Before TERRY J. OWENS, MURRIEL E. CRAWFORD, and ANITA PELLMAN GROSS, *Administrative Patent Judges*.

GROSS, *Administrative Patent Judge*.

DECISION ON APPEAL

STATEMENT OF THE CASE

William T. Graushar and John C. Geres (Appellants) appeal under 35 U.S.C. § 134 from the Examiner's final rejection of claims 1 through 4, 6 through 9, 11 through 14, 21, and 22. Claims 5, 10, and 15 through 20 have been withdrawn by the Examiner.

Appellants' invention relates to a method of producing magazines or other print media which include personalized optical disks. Claim 1 is illustrative of the claimed invention, and it reads as follows:

1. A method comprising:

writing electronic information to an optical disk on a binding line; and
associating the written optical disk with a printed product on the binding line.

The prior art references of record relied upon by the Examiner in rejecting the appealed claims are:

Harris, Jr.	US 5,114,128	May 19, 1992
Hill (Hill I)	US 5,388,815	Feb. 14, 1995
Pace	US 6,126,201	Oct. 03, 2000
Hill (Hill II)	US 6,431,453 B1	Aug. 13, 2002

Claims 1, 3, 6, 21, and 22 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Hill I.

Claims 11, 13, 14, and 22 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Hill II.

Claims 1 through 3, 6, 7, 21, and 22 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Pace in view of Hill I.

Claims 4, 8, and 9 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Pace in view of Hill I and Harris, Jr.

Claim 12 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Hill II in view of Harris, Jr.

We refer to the Examiner's Answer (mailed March 10, 2006) for the Examiner's complete reasoning and to Appellants' Brief (filed December 23,

2005) and Reply Brief (filed May 5, 2006) for Appellants' counterarguments.

SUMMARY OF DECISION

As a consequence of our review, we will reverse the anticipation and obviousness rejections of claims 1 through 4, 6 through 9, 11 through 14, 21, and 22.

OPINION

The Examiner (Answer 3) asserts that claims 1, 3, 6, 21, and 22 are anticipated by Hill I. Appellants contend (Br. 7) that Hill I fails to teach or suggest writing electronic information to an optical disk on a binding line. The first issue is whether Hill I discloses writing electronic information to an optical disk on a binding line, and, thus, whether the Examiner erred in rejecting claims 1, 3, 6, 21, and 22 under 35 U.S.C. § 102(b) over Hill I.

The Examiner asserts (Answer 3) that Hill's card 30 is an optical disk and that embosser section 20 is a binding line. In response to Appellants' argument (Br. 7) that "optical disk" is defined in the specification as a storage device such as a CD or DVD, the Examiner explains (Answer 5) that

defining the term "optical disk" as a CD or DVD would render the claims indefinite. The examiner notes that claim 2, which depends from claim 1, states, "the optical disk includes at least one of a CD, CD-ROM, and DVD." Since claim 2 limits the term "optical disk" to a CD, CD-ROM, and DVD, the term "optical disk" in claim 1 must be broader and encompass other storage mediums. Moreover, the appellant has not disclosed any characteristics about CDs or DVDs that distinguish them from any other storage device. Therefore, any storage device, including cards with magnetic strips, read [sic] on the term "optical disk" as recited in claims 1 and 6.

Hill I discloses (col. 4, ll. 45-68) a method of producing verified, embossed, and encoded credit cards mounted to matched carrier forms. The method includes the steps of embossing the face of a credit card, magnetically encoding similar information on a magnetic strip on the back of the card, and inserting the card into a verifiably matched and correctly printed carrier form. Nowhere does Hill I mention optical disks or a binding line.

The term "optical disk" is well-defined in the art as a storage disk that is read or played using a laser. The term includes CDs, CD-ROMs, laser disks, DVDs, digital optical disks, and numeric optical disks, as indicated by Appellants (Reply 2). Thus, contrary to the Examiner's assertions, the recitation of "optical disk" in claim 1 is broader than the recitation of a CD, CD-ROM, and DVD in claim 2 and need not encompass mediums such as cards with magnetic stripes, which are known not to be optical disks. A credit card which is embossed on one side and has a magnetic strip on the other side is neither optical nor a disk. Accordingly, Hill I fails to disclose writing electronic information to an optical disk.

"It is axiomatic that anticipation of a claim under § 102 can be found only if the prior art reference discloses every element of the claim." *In re King*, 801 F.2d 1324, 1326, 231 USPQ 136, 138 (Fed. Cir. 1986). *See also Lindemann Maschinenfabrik GMBH v. American Hoist and Derrick*, 730 F.2d 1452, 1458, 221 USPQ 481, 485 (Fed. Cir. 1984). Since Hill I lacks a teaching of an optical disk, Hill I cannot anticipate claims 1, 3, 6, 21, and 22.

The Examiner (Answer 3) asserts that claims 11, 13, 14, and 22 are anticipated by Hill II. Appellants contend (Br. 9) that Hill II, like Hill I, fails

to teach or suggest writing electronic information to an optical disk on a binding line. The second issue, therefore, is whether Hill II discloses writing electronic information to an optical disk on a binding line, and, thus, whether the Examiner erred in rejecting claims 11, 13, 14, and 22 under 35 U.S.C. § 102(e) over Hill II.

As explained *supra*, the term "optical disk" refers to any storage disk that is read or played using a laser. Hill II discloses (abstract) a system for inserting verified smart cards into corresponding carriers. The system includes readers for verifying the embossed, magnetic, and IC chip data as well as data encoded on a printed carrier. Nowhere does Hill II mention optical disks or a binding line.

The Examiner (Answer 3) points to elements 32, 44, and 46 as optical disks and (Answer 7) asserts that "I.C. chip 32, and bar code 44/46, each of which [are] written offline, [are] carrying electronic information, and being optically read." The Examiner appears to read "optical disk" for claims 11, 13, 14, and 22 in the same way as for claims 1, 3, 6, 21, and 22, as discussed *supra*. However, neither an IC chip nor a bar code satisfies the well-established definition of "optical disk." Therefore, Hill II fails to disclose writing to an optical. Consequently, Hill II does not anticipate claims 11, 13, 14, and 22.

The Examiner (Answer 3) asserts that claims 1 through 3, 6, 7, 21, and 22 are unpatentable over Pace in view of Hill I. Appellants contend (Br. 11) that Pace does not teach or suggest writing information on the CD while the CD is on the binding line. Further, Appellants contend (Br. 11) that neither reference teaches or suggests using the method of Hill I with an optical disk. The third issue, therefore, is the combination of Pace and Hill I

teaches writing to a CD on the binding line, and thus, whether the Examiner erred in rejecting claims 1 through 3, 6, 7, 21, and 22 under 35 U.S.C. § 103 over Pace in view of Hill I.

Pace discloses (abstract) inserting a compact disk into a folder with the folder positioned for binding the folder into a magazine. Pace does not disclose writing electronic information to or reading electronic information from the disk on the binding line, as admitted by the Examiner (Answer 3). Hill I discloses (col. 4, ll. 45-68) a method of producing verified, embossed, and encoded credit cards mounted to matched carrier forms. The method includes the steps of embossing the face of a credit card, magnetically encoding similar information on a magnetic strip on the back of the card, and inserting the card into a verifiably matched and correctly printed carrier form. We find nothing in Hill I that would suggest writing electronic information to or reading electronic information from a CD on a binding line. As neither reference teaches or suggests writing electronic information to or reading electronic information from the CD on the binding line, the Examiner failed to establish a *prima facie* case of obviousness.

The Examiner (Answer 3) adds Harris to the combination of Pace and Hill I in rejecting claims 4, 8, and 9 under 35 U.S.C. § 103. Appellants contend (Br. 14) that Harris fails to teach or suggest printing personalized indicia on the printed product after associating the optical disk with the printed product. Accordingly, the fourth issue is whether Harris teaches or suggests printing personalized indicia on the printed product after associating the optical disk with the printed product, and, thus, whether the Examiner erred in rejecting claims 4, 8, and 9 over Pace in view of Hill I and Harris.

Harris discloses (col. 7, ll. 58-59) feeding pre-printed signatures 16 to chain 12. After the magazine is assembled, it is stapled (see col. 8, ll. 21-24). Harris discloses (col. 7, ll. 24-28) that the assembled magazine is transferred to the printer 40 for receiving the name and address on the label on the cover. Thus, Harris discloses printing personalized indicia on the printed product after all personalized signatures are associated with the magazine. However, Harris makes no mention of optical disks as the pre-printed signatures. Thus, Harris fails to teach or suggest writing to or reading from an optical disk on the binding line, as required by the claims from which 4, 8, and 9 depend. Consequently, the combination of Pace, Hill I, and Harris fails to establish a *prima facie* case of obviousness for claims 4, 8, and 9.

The Examiner (Answer 4) rejects claim 12 under 35 U.S.C. § 103 over Hill II in view of Harris. The Examiner asserts (Answer 4) that "Hill discloses all the limitations of the claims [sic], but it doesn't disclose printing personalized indicia in response to what was read from the optical disk after associating." The Examiner uses Harris to remedy the alleged deficiency. Appellants contend (Br. 17) that there is no reason to combine a system that matches a credit card with a carrier and a printing system that generates magazines. The last issue, therefore, is whether the Examiner erred in rejecting claim 12 under 35 U.S.C. § 103 over Hill II in view of Harris.

As discussed *supra*, Hill II does not involve optical disks. Hill II discloses matching a smart card with its carrier. Harris discloses printing personalized indicia on a magazine after it is assembled with pre-printed signatures inside. Harris makes no mention of optical disks. We find no suggestion in either reference to read electronic information from an optical

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disk on a binding line and associate the optical disk with a printed product on the binding line. Therefore, the Examiner failed to establish a prima facie case of obviousness for claim 12 over Hill II in view of Harris.

ORDER

The decision of the Examiner rejecting claims 1, 3, 6, 11, 13, 14, 21, and 22 under 35 U.S.C. §§ 102(b) and (e) and claims 1 through 4, 6 through 9, 12, 21, and 22 under 35 U.S.C. § 103(a) is reversed.

REVERSED

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MICHAEL BEST & FRIEDRICH, LLP
100 E WISCONSIN AVENUE
Suite 3300
MILWAUKEE, WI 53202